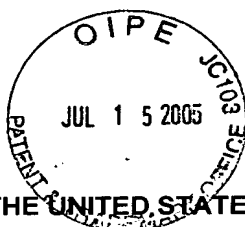


AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599



ATTORNEY DOCKET NO. 10003881-1

ZFW
AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Christopher K. Sutton

Serial No.: 09/991,020

Examiner: Emerson C. Puente

Filing Date: November 15, 2001

Group Art Unit: 2113

Title: Electronic Test Program with Selectable Specifications

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☐ No additional fee (Address envelope to "Mail Stop Amendments")
☒ Other: Corrected Appeal Brief (Fee \$____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	24	MINUS	24	= 0	X 50	\$ 0
INDEP. CLAIMS	4	MINUS	4	= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account **50-1078**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-1078** pursuant to 37 CFR 1.2 5. Additionally please charge any fees to Deposit Account **50-1078** under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Christopher K. Sutton

By Morley C. Tobey, Jr.
Morley C. Tobey, Jr.
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: July 13, 2005

Typed Name: Morley C. Tobey, Jr.

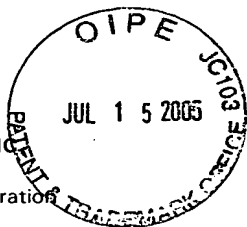
Signature: Morley C. Tobey, Jr.

Reg. No. 43,955

Date: July 13, 2005

Telephone No. (970) 669-1266

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, Colorado 80537-0599



PATENT APPLICATION
ATTORNEY DOCKET NO. 10003881-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Christopher K. Sutton

Serial No.:
09/991,020

Filed:
November 15, 2001

For:
**Electronic Test Program with
Selectable Specifications**

Confirmation Number:
2961

Examiner:
Emerson C. Puente

Group Art Unit:
2113

CORRECTED APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTION

Pursuant to the provisions of 37 C.F.R §1.191 *et seq.*, Applicant hereby appeals to the Board of Patent Appeals and Interferences (the "Board") from the examiner's final rejection dated 11/24/2004. A Response After Final Office Action under 37 CFR §1.116 was timely filed by Applicant on 01/19/2005. Subsequently Examiner

issued an Advisory Action on 02/04/2005. A Notice of Appeal was timely filed on 02/24/2004, in accordance with 37 CFR §1.8. This brief on appeal is being filed in triplicate (37 C.F.R §1.192(a)) and is accompanied by the requisite fee (37 C.F.R §1.192(a) and §1.17(c)).

REAL PARTY IN INTEREST

The entire interest in the present application has been assigned to Agilent Technologies, Inc. as recorded at Reel 012742, Frame 0247 on 03/25/2002.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1- 24 are pending.

Claims 1-24 have been finally rejected.

Claims 1-24 are on appeal.

STATUS OF AMENDMENTS

A Response After Final Office Action under 37 CFR §1.116 was filed by Applicant on 01/19/2005. That Response did not amend the Application, and there are no outstanding amendments.

SUMMARY OF CLAIMED SUBJECT MATTER

CLAIM 1: (Independent)

Claim 1 claims a product that provides a test executive program ([200] on page 6, lines 6-8; page 6, lines 27-28; and Figure 2 for example) for controlling (on page 8, lines 28-29 for example) a test ([203,205] on page 6, lines 13-15 and Figure 2 for example) on a device ([108] on page 5, line 30 and Figure 1 for example). The product comprises instructions (on page 5, lines 21-23 for example) for directing a processing unit ([102] on page 5, line 14 and Figure 1 for example) to (1) receive a selected one of a plurality of previously created alternative specifications (on page 3, lines 12-13; [323] on page 8, lines 9-10; and Figure 3 for example) for assessing a datapoint ([210-212,214] on page 6, lines 15-17; page 8, lines 19-21; Figure 2; and blocks 545-550 in Figure 5 for example) generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint, and (2) apply the selected specification to the datapoint generated by the test. The product further comprises a media ([101] on page 5, lines 13-21 and Figure 1 for example) readable by the processing unit that stores the instructions (page 5, lines 20-23 for example).

CLAIM 8: (Independent)

Claim 8 claims a method for providing a test executive program ([200] on page 6, lines 6-8; page 6, lines 27-28; and Figure 2 for example) that controls (on page 8, lines 28-29 for example) a test ([203,205] on page 6, lines 13-15 and Figure 2 for example) applied to a device ([108] on page 5, line 30 and Figure 1 for example). The method comprises receiving a selected one of a plurality of previously created alternative specifications (on page 3, lines 12-13; [323] on page 8, lines 9-10; and Figure 3 for example) for assessing a datapoint ([210-212,214] on page 6, lines 15-17; page 8, lines 19-21; Figure 2; and blocks 545-550 in Figure 5 for example) generated by a test and applying the selected specification to the datapoint generated by the test. Each of the plurality of alternative specifications is a different

specification for assessing the datapoint.

CLAIM 16: (Independent)

Claim 16 claims an electronic test system ([100] on page 5, lines 11-13 and Figure 1 for example). The electronic test system comprises a storing medium ([101] on page 5, lines 13-21 and Figure 1 for example), an input device ([104] on page 5, lines 13-14 and Figure 1 for example), a processor ([102] on page 5, line 14 and Figure 1 for example), and an output device ([106] on page 5, lines 13-14 and Figure 1 for example). The storing medium is configured for storing a test ([203,205] on page 6, lines 13-15 and Figure 2 for example) to be performed on a product other than the test system, a plurality of test datapoints ([210-212,214] on page 6, lines 15-17; page 8, lines 19-21; and Figure 2 for example) resulting from the test, and a plurality of sets of previously created alternative specifications (on page 3, lines 12-13; [323] on page 8, lines 9-10; and Figure 3 for example) for accessing the datapoints. Each of the plurality of alternative specifications is a different specification for assessing the datapoint ([210-212,214] on page 6, lines 15-17; page 8, lines 19-21; Figure 2; and blocks 545-550 in Figure 5 for example). The input device is configured for selecting one of the sets of alternative specifications (on page 3, lines 12-13; [323] on page 8, lines 9-10; and Figure 3 for example). The processor is responsive to the input device for receiving the set of specifications (on page 3, lines 12-13 for example) and comparing them with the datapoints (block 550 on Figure 5), and the output device is configured for presenting the results of the comparison ([322] on Figure 3 for example).

CLAIM 21: (Independent)

Claim 21 claims a computer readable memory device ([101] on page 5, lines 13-21 and Figure 1 for example). The computer readable memory device embodies a computer program ([200] on page 6, lines 6-8; page 6, lines 27-28; and Figure 2 for example) of instructions (on page 5, lines 21-23 for example) executable by a computer ([100] on page 5, lines 11-13 and Figure 1 for example). The instructions comprise receiving a selected one of a plurality of previously created alternative specifications (on page 3, lines 12-13; [323] on page 8, lines 9-10; and Figure 3 for

example) for assessing a datapoint ([210-212,214] on page 6, lines 15-17; page 8, lines 19-21; Figure 2; and blocks 545-550 in Figure 5 for example) generated by a test ([203,205] on page 6, lines 13-15 and Figure 2 for example) and applying the selected specification to the datapoint generated by the test. Each of the plurality of alternative specifications is a different specification for assessing the datapoint.

CLAIM 2: (Dependent)

Claim 2 depends from claim 1. In addition to the elements of claim 1, in claim 2 the instructions further comprise instructions for directing the processing unit to receive a request for a display of the plurality of specifications available, to determine the plurality of specifications available, and to display the plurality of specifications (on page 3, lines 16-19 and Figure 5 for example).

CLAIM 3: (Dependent)

Claim 3 depends from claim 2. In addition to the elements of claim 2, in claim 3 the request comprises the selection of an option of a displayed menu (on page 3, lines 19-20; page 8, line 28 to page 9, line 5; and Figure 5 for example).

CLAIM 4: (Dependent)

Claim 4 depends from claim 2. In addition to the elements of claim 2, in claim 4 the plurality of specifications available is displayed on a menu ([420,430,440] on page 2, line 33 to page 3, line 6; page 9, lines 12-20; and Figures 4-5 for example).

CLAIM 5: (Dependent)

Claim 5 depends from claim 4. In addition to the elements of claim 4, in claim 5 the received selected specification is received as a choice from the menu of the plurality of specifications available ([420,430,440] on page 2, line 33 to page 3, line 6; page 9, lines 12-20; and Figures 4-5 for example).

CLAIM 6: (Dependent)

Claim 6 depends from claim 2. In addition to the elements of claim 2, in claim 6 the instructions for determining the plurality of specifications available comprises instructions for directing the processing unit to determine the device being tested (on page 3, lines 2-6 and blocks 520 on Figure 5 for example) .

CLAIM 7: (Dependent)

Claim 7 depends from claim 2. In addition to the elements of claim 2, in claim 7 the instructions for determining the plurality of specifications available comprises instructions for directing the processing unit to determine the test being applied to the device (on page 3, lines 2-6 and blocks 530 on Figure 5 for example).

CLAIM 20: (Dependent)

Claim 20 depends from claim 16. In addition to the elements of claim 16, in claim 20 the stored test includes an operational test and an environmental test (on page 4, lines 21-22 for example).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

- (1) Claims 1-19 and 21-24 were rejected under 35 USC § 102(e) as allegedly being anticipated by *Akash* in U.S. Patent Number 6,134,674 entitled "Computer Based Test Operating System" hereinafter *Akash*, and
- (2) Claim 20 was rejected under 35 USC § 103(a) as allegedly being unpatentable over *Akash* in view of Applicant's alleged admitted prior art, hereinafter *AAPA*.

ARGUMENT

1. REJECTION OF CLAIMS 1-19 & 21-24 UNDER U.S.C. §102(e):

In the section entitled "Claim Rejections - 35 U.S.C. §102" on page 2 of the Final Office Action mailed on 24 November 2004 (Paper No./Mail Date 20041119) referred to hereinafter as the Final Office Action of 24 November 2004, claims 1-19 and 21-24 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Akasheh*. Applicant respectively traverses.

As stated in MPEP 2131 "To anticipate a claim, the reference must teach every element of the claim." As will be shown in the following paragraphs, *Akasheh* fails to teach every element of claims 1-19 and 21-24.

1.1 Regarding Rejection of Independent Claims 1, 8, & 21 Under 35 U.S.C. §102(e):

Among other items, *Akasheh* does not disclose instructions for directing a processing unit to "receive a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint" as claim 1 of the Present Application does. The Office Action of 24 November 2004 alleges that *Akasheh* "discloses a test file which stores associated tolerances for testing (see column 2 lines 52-54) and further states the user may select various test tolerance criteria (see column 9 lines 16-18)."

However, in the cited sections, *Akasheh* discloses that "A test file stores the test data, test step names, device parameters and associated tolerances used for testing a UUT." Note that *Akasheh* indicates for each parameter only ONE associated tolerance condition. Tolerances are associated with a plurality of device parameters, but *Akasheh* does NOT indicate more than one tolerance condition associated with any one device parameter. Also, in the cited sections, *Akasheh* discloses that "In step 207, a user may select various test tolerance criteria for testing the UUTs ... using the tolerance manager (TM)." In *Akasheh*, a User uses the tolerance manager to set the

tolerance condition for a given parameter of interest. *Akasheh* does NOT disclose an instruction for receiving "a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint" wherein the datapoint is representative of *Akasheh's* parameter. The User in *Akasheh* employs the tolerance manager to set the tolerance condition for a given parameter and then applies that condition to the test to be conducted. A "plurality of previously created alternative specifications" for each parameter was NOT disclosed in *Akasheh*. *Akasheh* does NOT indicate ALTERNATIVE specifications. He instead indicates ONE associated specification condition for EACH of multiple parameters. This is not the same as alternative specifications for any given parameter.

Applicant maintains that *Akasheh* does NOT disclose receiving a selected "one of a plurality of previously created alternative specifications" which can be used for a particular datapoint. In *Akasheh* each of the instruments 112.sub.1 ... 112.sub.N individually measures a separate item analogous to a datapoint of the Present Application and each of the instruments 112.sub.1 ... 112.sub.N individually uses its ONE AND ONLY specified criteria for evaluation of its datapoint. The criteria for each of the instruments is NOT selected from ALTERNATIVE specifications.

Arguments similar to that made for independent claim 1 above are applicable to the patentability of independent claims 8 and 21.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 1, 8, and 21. Because *Akasheh* fails to teach every element of claims 1, 8, and 21 as required by MPEP 2131, *Akasheh* does not anticipate claims 1, 8, and 21. In addition, *Akasheh* fails to suggest every element of claims 1, 8, and 21. Thus, claims 1, 8, and 21 are allowable over *Akasheh*.

1.2 Regarding Rejection of Dependent Claims 2, 9, 15, & 22 Under 35 U.S.C. §102(e):

Claim 2 is separately patentable from those grouped above as it comprises subject matter not found in that group. In particular, this claim includes, among other

items, the additional elements of instructions for directing the processing unit to “receive a request for a display of said plurality of specifications available, determine said plurality of specifications available, and display said plurality of specifications”.

The Final Office Action of 24 November 2004 referenced column 11 lines 42-53 and column 13 lines 51-57 of *Akasheh* in rejecting claim 2. However, these lines refer to a user setting the tolerance for a particular parameter or parameters. Whereas, in the Present Application, the criteria for each of the instruments is selected from ALTERNATIVE specifications. Further, *Akasheh* does NOT “receive a request for a display of said plurality of specifications available, determine said plurality of specifications available, and display said plurality of specifications” since there are not a plurality of specifications to display and from which to apply. In *Akasheh* any such specifications are entered individually. A request is not received for such a display of a plurality of specifications that are available. Neither is a determination made as to which plurality of specifications are available. Nor is a display of such a plurality of specifications displayed.

Further, since claim 2 depends from claim 1, arguments similar to that made for claim 1 above are applicable to the patentability of claim 2.

Arguments similar to that made for dependent claim 2 above are applicable to the patentability of dependent claims 9 and 22. And, as claim 9 depends from claim 8, arguments similar to that made for claim 8 above are applicable to the patentability of claim 9. Further, as claim 22 depends from claim 21, arguments similar to that made for claim 21 above are applicable to the patentability of claim 22. In addition, since claim 15 depends from claim 9 which depends from claim 8, arguments similar to that made for claims 8 and 9 above are applicable to the patentability of claim 15.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 2, 9, 15, and 22. Because *Akasheh* fails to teach every element of claims 2, 9, 15, and 22 as required by MPEP 2131, *Akasheh* does not anticipate claims 2, 9, 15, and 22. In addition, *Akasheh* fails to suggest every element of claims 2, 9, 15, and 22. Thus, claims 2, 9, 15, and 22 are allowable over *Akasheh*.

1.3 Regarding Rejection of Dependent Claims 3 & 10 Under 35 U.S.C. §102(e):

Claim 3 is separately patentable from those grouped above as it comprises subject matter not found in those groups. In particular, this claim includes, among other items, the additional element of the request comprising “the selection of an option of a displayed menu.”

The Final Office Action of 24 November 2004 referenced column 11 lines 42-53 and Figure 3d of *Akasheh* in rejecting claim 3. However, these lines and figure in *Akasheh* refer to an instrument interface module (IIM) that can operate “in three modes: a set-up mode, an execute mode and a virtual panel mode.” They do NOT refer to the receipt of a request for display of a plurality of specifications.” as in claim 3 of the Present Application.

Further, since claim 3 depends from claims 1 and 2, arguments similar to that made for claims 1 and 2 above are applicable to the patentability of claim 3.

Arguments similar to that made for dependent claim 3 above are applicable to the patentability of dependent claim 10. And, as claim 10 depends from claims 8 and 9, arguments similar to that made for claims 8 and 9 above are applicable to the patentability of claim 10.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 3 and 10. Because *Akasheh* fails to teach every element of claims 3 and 10 as required by MPEP 2131, *Akasheh* does not anticipate claims 3 and 10. In addition, *Akasheh* fails to suggest every element of claims 3 and 10. Thus, claims 3 and 10 are allowable over *Akasheh*.

1.4 Regarding Rejection of Dependent Claims 4 & 11 Under 35 U.S.C. §102(e):

Claim 4 is separately patentable from those grouped above as it comprises subject matter not found in those groups. In particular, this claim includes, among other items, the additional element of the plurality of specifications available being “displayed on a menu”.

The Final Office Action of 24 November 2004 referenced column 13 lines 51-57 and Figure 8 of *Akasheh* in rejecting claim 4. However, these lines and figure in

Akasheh refer to a single tolerance condition for any given parameter. They do NOT refer to the display on a menu of a plurality of specifications as in claim 4 of the Present Application.

Further, since claim 4 depends from claims 1 and 2, arguments similar to that made for claims 1 and 2 above are applicable to the patentability of claim 4.

Arguments similar to that made for dependent claim 4 above are applicable to the patentability of dependent claim 11. And, as claim 11 depends from claims 8 and 9, arguments similar to that made for claims 8 and 9 above are applicable to the patentability of claim 11.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 4 and 11. Because *Akasheh* fails to teach every element of claims 4 and 11 as required by MPEP 2131, *Akasheh* does not anticipate claims 4 and 11. In addition, *Akasheh* fails to suggest every element of claims 4 and 11. Thus, claims 4 and 11 are allowable over *Akasheh*.

1.5 Regarding Rejection of Dependent Claims 5 & 12 Under 35 U.S.C. §102(e):

Claim 5 is separately patentable from those grouped above as it comprises subject matter not found in those groups. In particular, this claim includes, among other items, the additional element of receiving the selected specification “as a choice from said menu of said plurality of specifications available”.

The Final Office Action of 24 November 2004 referenced column 13 lines 51-57 of *Akasheh* in rejecting claim 5. However, these lines in *Akasheh* refer to a single tolerance condition for any given parameter. They do NOT refer to the reception of a choice from a menu of a plurality of specifications that are available.

Further, since claim 5 depends from claims 1, 2, and 4, arguments similar to that made for claims 1, 2, and 4 above are applicable to the patentability of claim 5.

Arguments similar to that made for dependent claim 5 above are applicable to the patentability of dependent claim 12. And, as claim 12 depends from claims 8, 9, and 11, arguments similar to that made for claims 8, 9, and 11 above are applicable to the patentability of claim 12.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 5 and 12. Because *Akasheh* fails to teach every element of claims 5 and 12 as required by MPEP 2131, *Akasheh* does not anticipate claims 5 and 12. In addition, *Akasheh* fails to suggest every element of claims 5 and 12. Thus, claims 5 and 12 are allowable over *Akasheh*.

1.6 Regarding Rejection of Dependent Claims 6, 13, & 23 Under 35 U.S.C. §102(e):

Claim 6 is separately patentable from those grouped above as it comprises subject matter not found in those groups. In particular, this claim includes, among other items, the additional element of instructions for determining the plurality of specifications available comprising “instructions for directing said processing unit to determine said device being tested”.

The Final Office Action of 24 November 2004 referenced column 16 lines 25-40 of *Akasheh* in rejecting claim 6. However, these lines in *Akasheh* refer to a user making a selection. They do NOT refer to directing a processing unit to determine the device being tested.

Further, since claim 6 depends from claims 1 and 2, arguments similar to that made for claims 1 and 2 above are applicable to the patentability of claim 6.

Arguments similar to that made for dependent claim 6 above are applicable to the patentability of dependent claims 13 and 23. And, as claim 13 depends from claims 8 and 9, arguments similar to that made for claims 8 and 9 above are applicable to the patentability of claim 13. Also, as claim 23 depends from claims 21 and 22, arguments similar to that made for claims 21 and 22 above are applicable to the patentability of claim 23.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 6, 13, and 23. Because *Akasheh* fails to teach every element of claims 6, 13, and 23 as required by MPEP 2131, *Akasheh* does not anticipate claims 6, 13, and 23. In addition, *Akasheh* fails to suggest every element of claims 6, 13, and 23. Thus, claims 6, 13, and 23 are allowable over *Akasheh*.

1.7 Regarding Rejection of Dependent Claims 7, 14, & 24 Under 35 U.S.C. §102(e):

Claim 7 is separately patentable from those grouped above as it comprises subject matter not found in those groups. In particular, this claim includes, among other items, the additional element of instructions for determining the plurality of specifications available comprising “instructions for directing said processing unit to determine said test being applied to said device”.

The Final Office Action of 24 November 2004 referenced column 12 lines 25-30 of *Akasheh* in rejecting claim 7. However, these lines in *Akasheh* refer to a user making a selection. They do NOT refer to directing a processing unit to determine the test being applied to a device.

Further, since claim 7 depends from claims 1 and 2, arguments similar to that made for claims 1 and 2 above are applicable to the patentability of claim 7.

Arguments similar to that made for dependent claim 7 above are applicable to the patentability of dependent claims 14 and 24. And, as claim 14 depends from claims 8 and 9, arguments similar to that made for claims 8 and 9 above are applicable to the patentability of claim 14. Also, as claim 24 depends from claims 21 and 22, arguments similar to that made for claims 21 and 22 above are applicable to the patentability of claim 24.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 7, 14, and 24. Because *Akasheh* fails to teach every element of claims 7, 14, and 24 as required by MPEP 2131, *Akasheh* does not anticipate claims 7, 14, and 24. In addition, *Akasheh* fails to suggest every element of claims 7, 14, and 24. Thus, claims 7, 14, and 24 are allowable over *Akasheh*.

1.8 Regarding Rejection of Independent Claim 16 & Dependent Claims 17-19 Under 35 U.S.C. §102(e):

Claims 16-19 are separately patentable from those grouped above as they comprise subject matter not found in those groups. In particular, these claims include,

among other items, the additional elements of “an input device” and “an output device”.

The Final Office Action of 24 November 2004 referenced column 2 lines 52-54 and column 9 lines 16-18 of *Akasheh* in rejecting claim 16. These lines in *Akasheh* refer to a test file that stores user specified tolerances for each test to be performed. Whereas, claim 16 of the Present Application specify “a PLURALITY of sets of previously created alternative specifications”. Referring to Figure 4 of *Akasheh*, note that in block 415 the setup user interface is displayed with the default instrument settings and NO TOLERANCE DATA. Tolerance data is added by the user in block 410. A plurality of sets of previously created alternative specifications is not stored by *Akasheh*.

The Final Office Action of 24 November 2004 makes further reference to column 9 lines 15-21 of *Akasheh* which in turn references block 207 of Figure 2a. In block 207, the user is allowed to select the test tolerance criteria. Whereas, in claim 16 of the Present Application one of sets of PREVIOUSLY CREATED ALTERNATIVE SPECIFICATIONS is selected. Note that the word “select” in *Akasheh* is used in the sense of “input” NOT as in the Present Application wherein “select” is used in the sense of “choose” from previously created alternative specifications. *Akasheh* does NOT indicate ALTERNATIVE specifications. He instead indicates ONE associated specification condition inputted for EACH of multiple parameters. This is not the same as alternative specifications for any given parameter.

Applicant maintains that *Akasheh* does NOT disclose the selection of “one of a plurality of previously created alternative specifications” which can be used for a particular datapoint. In *Akasheh* each of the instruments 112.sub.1 ... 112.sub.N individually measures a separate item analogous to a datapoint of the Present Application and each of the instruments 112.sub.1 ... 112.sub.N individually uses its ONE AND ONLY specified criteria for evaluation of its datapoint. The criteria for each of the instruments is NOT selected from ALTERNATIVE specifications.

Further, since claims 17-19 depend from claim 16, arguments similar to that made for claim 16 above are applicable to the patentability of claims 17-19.

Thus, Applicant has demonstrated that *Akasheh* fails to teach every element of claims 16-19. Because *Akasheh* fails to teach every element of claims 16-19 as required by MPEP 2131, *Akasheh* does not anticipate claims 16-19. In addition, *Akasheh* fails to suggest every element of claims 16-19. Thus, claims 16-19 are allowable over *Akasheh*.

2. REJECTION OF CLAIM 20 UNDER 35 U.S.C. §103(a):

In the section entitled “Claim Rejections - 35 U.S.C. §103” beginning on page 6 of the Final Office Action of 24 November 2004, claim 20 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Akasheh* in view of Applicant’s alleged admitted prior art, hereinafter *AAPA*. Applicant respectfully traverses.

Referring to MPEP 2142, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

2.1 Regarding Rejection of Claim 20 Under 35 U.S.C. § 103(a):

Claim 20 is separately patentable from those grouped above as it comprises subject matter not found in those groups. In particular, this claim includes, among

other items, the additional elements of a test that includes “an operational test and an environmental test”.

With respect to the rejection of claim 20 under 35 U.S.C. § 103(a), it is noted that dependent claim 20 depends from independent claim 16 and that, as such, dependent claim 20 has all the features described above for claim 16 as elements. As demonstrated above, among other items, *Akasheh* does not disclose a storing medium storing “a plurality of sets of previously created alternative specifications for accessing said datapoints, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint” which is an element of claim 16 of the Present Application. Nor does the alleged *AAPA* disclose such. Nor does the alleged *AAPA* disclose or imply an environmental test.

Thus, the cited references do not teach nor do they suggest all the claim elements of claim 20 as required by MPEP 2142. As such, claim 20 is not obvious over *Akasheh* in view of the alleged *AAPA*, and it follows that claim 20 is allowable.

3. SUMMARY & CONCLUSION:

In summary, the claims of the Present Application are changed with regard to the cited alleged prior art. There is a lack of suggestion or motivation to modify “the teachings of the alleged prior art to produce the claimed invention”, and all claim elements are not “taught or suggested by the prior art”. Nor would it have been obvious to one of ordinary skill in the art at the time of the Present Invention to have combined and/or modified the teachings of the alleged prior art. Thus, the Present Application is nonobvious over alleged prior art.

Applicant respectfully requests the Board to reverse the final rejection and to order the examiner to pass this application to allowance and issue.

Respectfully submitted,

by Morley C. Tobey, Jr.

Morley C. Tobey, Jr.

Reg. No. 43,955

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Loveland, CO 80537

(970) 669-1266

CLAIMS APPENDIX

Claims 1-24 are presented below in their final accepted form as amended under 37 CFR §1.116 following final rejection on 11/24/2004.

1. A product that provides a test executive program for controlling a test on a device, said product comprising:

instructions for directing a processing unit to:

receive a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint, and

apply said selected specification to said datapoint generated by said test; and

a media readable by said processing unit that stores said instructions.

2. The product of claim 1 wherein said instructions further comprise instructions for directing said processing unit to:

receive a request for a display of said plurality of specifications available,

determine said plurality of specifications available, and

display said plurality of specifications.

3. The product of claim 2 wherein said request comprises the selection of an option of a displayed menu.
4. The product of claim 2 wherein said plurality of specifications available is displayed on a menu.
5. The product of claim 4 wherein said received selected specification is received as a choice from said menu of said plurality of specifications available.
6. The product of claim 2 wherein said instructions for determining said plurality of specifications available comprises instructions for directing said processing unit to determine said device being tested.
7. The product of claim 2 wherein said instructions for determining said plurality of specifications available comprises instructions for directing said processing unit to determine said test being applied to said device.
8. A method for providing a test executive program that controls a test applied to a device, comprising:

receiving a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint; and

applying said selected specification to said datapoint generated by said test.

9. The method of claim 8, further comprising:

receiving a request for a display of said plurality of specifications available;

determining said plurality of specifications available; and

displaying said plurality of specifications.
10. The method of claim 9 wherein said request is a selection of an option of a displayed menu.
11. The method of claim 9 wherein said plurality of specifications available is displayed on a menu.
12. The method of claim 11 wherein said receiving selected specification is received as a choice from said menu of said plurality of specifications available.
13. The method of claim 9 wherein said determining said plurality of specifications available comprises determining said device being tested.
14. The method of claim 9 wherein said determining said plurality of specifications available comprises determining said test being applied to said device.
15. The method of claim 9 further comprising updating a display of results of said test compared to said selected specification.

16. An electronic test system comprising:
- a storing medium storing a test to be performed on a product other than said test system, a plurality of test datapoints resulting from said test, and a plurality of sets of previously created alternative specifications for accessing said datapoints, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint;
- an input device for selecting one of said sets of alternative specifications;
- a processor responsive to said input device for receiving said set of specifications and comparing them with said datapoints; and
- an output device for presenting the results of said comparison.
17. An electronic test system as in claim 16 wherein said input device comprises a menu on a display and a manual device for selecting an item on said menu.
18. An electronic test system as in claim 16 wherein said output device comprises a display.
19. An electronic test system as in claim 16 wherein said storing medium comprises an electronic memory.
20. An electronic test system as in claim 16 wherein said stored test includes an operational test and an environmental test.

21. A computer readable memory device embodying a computer program of instructions executable by a computer, the instructions comprising:

receiving a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint; and

applying said selected specification to said datapoint generated by said test.

22. The computer readable memory device as recited in claim 21, the instructions further comprising:

receiving a request for a display of said plurality of specifications available;

determining said plurality of specifications available; and

displaying said plurality of specifications.

23. The computer readable memory device as recited in claim 22, wherein said determining said plurality of specifications available comprises determining said device being tested.

24. The computer readable memory device as recited in claim 22, wherein said determining said plurality of specifications available comprises determining said test being applied to said device.

EVIDENCE APPENDIX

None.